

REMARKS

Claims 1-9 and 11-22 are currently pending in the application. By this response, claims 1, 6, and 16 are amended for the Examiner's consideration. The amendments do not add new matter, and are fully supported by the original disclosure. For example, support for the amendments is provided at lines 15-17 and 25-27 of page 2 of the specification as originally filed. Reconsideration of the rejected claims in view of the amendments and the following remarks is respectfully requested.

Allowable Subject Matter

Applicants appreciate the indication that claim 6 contains allowable subject matter. By this response, claim 6 is presented in independent form, and should be allowed. Moreover, Applicants respectfully submit that all pending claims are allowable for the reasons discussed herein.

Restriction By Original Presentation

The Examiner has withdrawn claim 22 from consideration as being directed to a non-elected invention pursuant to constructive election by original presentation as set forth in 37 CFR §1.145 and as described in MPEP §821.03. The Examiner contends the restriction of claim 22 is proper under MPEP §806.05(f). This restriction is respectfully traversed.

Applicants repeat the arguments previously presented that it is improper to withdraw a linking claim from consideration when the linking claim links the elected invention to a non-elected invention. MPEP §809 explicitly mandates that "[t]he linking claims must be examined with, and thus are considered part of, the invention elected." Similarly, MPEP

§814 states that a linking claim must be examined with the elected invention.¹ Since the Examiner has acknowledged that claim 22 is a linking claim, Applicants respectfully submit that claim 22 should be examined on the merits with the elected invention.

35 U.S.C. §102 Rejection

Claims 1, 2, 8, 16, 17, and 21 are rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 5,145,732 issued to Kyutoku et al. (“Kyutoku”). This rejection is respectfully traversed.

A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). See MPEP §2131. Applicants submit that the applied art does not show each and every feature of the claimed invention.

The present invention relates generally to a panel and, more particularly, to a panel having a non-uniform density distribution throughout its thickness. In an exemplary embodiment, the panel is composed of a woodbased material. Particularly, independent claim 1 recites, *inter alia*, a panel having a support board made of glued and compressed woodbased material to which a termination layer is applied in each case on a top side and an underside. Independent claim 16 recites, *inter alia*, a panel, comprising a support board composed of glued, compressed fiber woodbased material. Applicants respectfully submit that Kyutoku does not disclose a support board made of glued and compressed woodbased material.

¹ MPEP §814 specifically states: “The generic or other linking claims should not be associated with any one of the linked inventions since such claims must be examined with the elected invention.”

Instead, Kyutoku discloses a felt 1 composed of polymer fibers. Applicants submit that polymer fibers are not a woodbased material, and that Kyutoku makes no mention whatsoever of woodbased material. To the contrary, Kyutoku only describes polymer fibers, and teaches that examples of such polymer fibers include: phenol resin-type fibers, polymer fibers such as heat shrinkable polyacrylonitrile fibers, rayon fibers or the like; non-melting fibers having no definite heat-melting point such as aramid-type fibers or the like; and fibers of the thermosetting type such as fibers of epoxy resin, polyurethane, urea resin or the like (col. 5, lines 28-35). As such, Kyutoku clearly does not disclose a support board made of glued and compressed woodbased material, as recited in the claimed invention.

Claims 1 and 16 additionally recite the support board has termination layers applied on a top side and an underside. Kyutoku does not disclose a support board having a termination layer applied to the top side and the underside. Instead, Kyutoku discloses a felt 1 having a carbon-based sheet 2 arranged on a top side of the felt 1. Even assuming *arguendo* that felt 1 constitutes a support board (an assumption with which Applicants disagree), Kyutoku only discloses such a sheet 2 on the top side. Kyutoku does not disclose any such a sheet (or any element that could be considered a termination layer) on the bottom side of the felt. Therefore, Kyutoku does not disclose a support board having a termination layer applied on a top side and an underside.

Claim 1 additionally recites that termination layer on the top side has a structured surface. Kyutoku does not show a support board having a termination layer on its upper side where the termination layer has a structured surface. Even assuming *arguendo* that felt 1 constitutes a support board and carbon sheet 2 comprises a termination layer (an assumption with which Applicants disagree), Kyutoku does not disclose that sheet 2 has a structured surface. Instead, the sheet 2 is depicted as smooth and featureless in the figures (e.g., FIG. 2).

Claim 16 additionally recites the density of the support board continuously decreases from the top side to a substantial midpoint of the support board, and continuously decreases from the underside to the substantial midpoint. Kyutoku does not disclose these features. Applicants acknowledge that Kyutoku discloses that the bulk density of the carbon fiber felt may vary continuously in the thickness direction (see, e.g., lines 21-45 of col. 6). However, this description does not disclose or imply the density of the support board continuously decreases from the top side to a substantial midpoint of the support board, and continuously decreases from the underside to the substantial midpoint.

Applicants respectfully submit that Kyutoku does not disclose at least the above-noted features of independent claims 1 and 16. Therefore, Kyutoku cannot reasonably be said to anticipate the claimed invention. Claims 2, 8, 17, and 21 depend from claims 1 or 16, respectively, and are allowable at least for the reasons discussed above with respect to claims 1 and 16. Moreover, the applied art does not disclose many of the additional features recited in these dependent claims.

Accordingly, Applicants respectfully request that the §102 rejection of claims 1, 2, 8, 16, 17, and 21 be withdrawn.

35 U.S.C. §103 Rejection

Claims 3, 9, and 18-20 are rejected under 35 U.S.C. §103(a) for being unpatentable over U.S. Patent No. 5,145,732 issued to Kyutoku. Moreover, claims 3, 9, and 18-20 are rejected under 35 U.S.C. §103(a) for being unpatentable over Kyutoku in view of U.S. Patent No. 5,855,832 issued to Clausi et al. (“Clausi”).² These rejections are respectfully traversed.

Claims 3, 9, and 18-20 in view of Kyutoku

As discussed above, Kyutoku does not disclose or suggest many of the features of independent claims 1 and 16. Therefore, Kyutoku alone cannot arguably support a rejection of claims 3, 9, and 18-20, which depend from claims 1 or 16, respectively. Moreover, Kyutoku does not disclose or suggest many of the additional features recited in these dependent claims.

For example, Kyutoku does not disclose or suggest the first termination layer comprises a decoration, as recited in claim 18. In fact, Kyutoku does not disclose any element that comprises a decoration. The Examiner contends that Kyutoku discloses the invention can be useful in a variety of articles which would include decorative articles. Without acquiescing in this unsupported assertion, Applicants note that the Examiner’s explanation does not address the language of the claim. That is, the claim does not recite that the panel is used in an article comprising a decoration, as the Examiner seems to suggest; instead, the claim recites that the termination layer comprises a decoration. Kyutoku simply does not disclose or suggest a support board having a termination layer, where the termination layer comprises a decoration.

Furthermore, Kyutoku does not disclose or suggest the first termination layer comprises a structure composed of a stamping, as recited in claim 19. In fact, Kyutoku does not disclose any

² Applicants assume that claims 4, 5, and 7 are rejected in view of Kyutoku and Clausi, not claims 3, 9, and 18-20 as paragraph 7 of the Office Action states. This is because the explanation of the rejection appears to address the features recited in claims 4, 5, and 7, and the Office Action Summary identifies claims 4, 5, and 7 as being rejected.

element that comprises a stamping. The Examiner contends that Kyutoku discloses the invention can be useful in a variety of articles which would include stamped articles. Without acquiescing in this unsupported assertion, Applicants note that the Examiner's explanation does not address the language of the claim. That is, the claim does not recite that the panel is used in a stamped article, as the Examiner seems to suggest; instead, the claim recites that the termination layer comprises a structure composed of a stamping. Kyutoku simply does not disclose or suggest a support board having a termination layer, where the termination layer comprises a structure composed of a stamping.

Even further, Kyutoku does not disclose or suggest a density distribution through a thickness of the support board is substantially parabolic in shape, as recited in claim 20. Kyutoku simply makes no mention of a substantially parabolic-shaped density distribution. Moreover, the Examiner failed to address this feature of the claimed invention in the explanation of the rejection.

Accordingly, Applicants respectfully request that the §103 rejection of claims 3, 9, and 18-20 be withdrawn.

Claims 4, 5, and 7 in view of Kyutoku and Clausi

Claims 4, 5, and 7 depend from allowable independent claim 1. As discussed above, Kyutoku does not disclose or suggest many of the features of claim 1. Clausi does not compensate for the deficiencies of Kyutoku with respect to claim 1. That is, Clausi does not disclose or suggest a panel having a support board made of glued and compressed woodbased material to which a termination layer is applied in each case on a top side and an underside, and the termination layer of the top side has a structured surface, as recited in claim 1. Therefore, the applied references do not disclose or suggest all of the features of the claimed invention.

Moreover, Applicants submit that it is improper to combine Kyutoku and Clausi as suggested by the Examiner. Clausi discloses the use of resin binders (e.g., urea formaldehyde, melamine-formaldehyde, etc.) with plant-based fibers. There is no suggestion of using such binders with the polymer fibers used by Kyutoku. Also, there is no reasonable expectation of success of using such binders with the polymer fibers disclosed by Kyutoku. Therefore, the rejection based upon the Examiner's suggested combination of Kyutoku and Clausi is improper and should be withdrawn.

Accordingly, Applicants respectfully request that the §103 rejection of claims 4, 5, and 7 be withdrawn.

Rejoinder of Withdrawn Claims

Applicants respectfully submit that claim 22 is a linking claim in accordance with MPEP §809.03. More particularly, claim 22 includes the process limitations of claim 11 and depends from product claim 1, thereby linking the process and the product. Therefore, pursuant to MPEP §821.04, rejoinder of withdrawn claims 11-15 is proper since the elected "panel invention" is allowable, and all claims to the non-elected "process invention" depend from or otherwise require all the limitations of an allowable claim (i.e., allowable claim 22 includes all of the features of claims 1 and 11).

Accordingly, Applicants respectfully request that claims 11-15 be rejoined, and claims 1-9 and 11-22 be allowed.

Other Matters

Applicants note that Office Action Summary indicates claims 4, 5, and 7 as being rejected; however, the Examiner did not identify and set forth a rejection of claims 4, 5, and 7 in the Detailed Action of the outstanding Office Action. Although Applicants present arguments above as if these claims are rejected under 35 U.S.C. § 103(a) as being unpatentable in view of Kyotuk and Clausi, these arguments are only for the purpose of providing a complete response to the outstanding Office Action. Since the Examiner did not specifically and clearly point out how claims 4, 5, and 7 are rejected, Applicants submit the record is unclear on this issue.

For these reasons, Applicants submit that a clear issue was not developed between the Examiner and Applicants. As such, Applicants submit that the next Office Action should clarify this issue and cannot properly be made final.

According to MPEP 706,

Before final rejection is in order a clear issue should be developed between the examiner and applicant. To bring the prosecution to as speedy conclusion as possible and at the same time to deal justly by both the applicant and the public, the invention as disclosed and claimed should be thoroughly searched in the first action and the references fully applied; and in reply to this action the applicant should amend with a view to avoiding all the grounds of rejection and objection.

Additionally, MPEP 706.07(a) notes:

Under present practice, second or any subsequent actions on the merits shall be final, except where the examiner introduces a new ground of rejection that is neither necessitated by applicant's amendment of the claims nor based on information submitted in an information disclosure statement filed during the period set forth in 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17(p). ...

Furthermore, a second or any subsequent action on the merits in any application ... will not be made final if it includes a rejection, on newly cited art, other than information submitted in an information disclosure statement filed under 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17 (p), of any claim not

amended by applicant or patent owner in spite of the fact that other claims may have been amended to require newly cited art.

Accordingly, Applicants respectfully request clarification of the rejection of claims 4, 5, and 7 in the next Office Action. Moreover, as the rejection of these claims has not yet been clearly developed by the Examiner, Applicants respectfully submit that the next Office Action cannot properly be made final.

CONCLUSION

In view of the foregoing amendments and remarks, Applicants submit that all of the claims are patentably distinct from the prior art of record and are in condition for allowance. The Examiner is respectfully requested to pass the above application to issue. The Examiner is invited to contact the undersigned at the telephone number listed below, if needed. Applicants hereby make a written conditional petition for extension of time, if required. Please charge any deficiencies in fees and credit any overpayment of fees to Attorney's Deposit Account No. 19-0089.

Respectfully submitted,
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